

ARGUMENT

Claims 1-12 are pending, with Claims 1, 5, and 7 being the only independent claims. No amendments have been made in the current Reply, as it is believed that the pending claims are in condition for allowance.

In the Final Office Action dated December 5, 2003, the Examiner rejected all pending claims (Claims 1-12) under 35 U.S.C. §103(a) as unpatentable over *Buhrmann et al.* (US 5,950,125; hereinafter *Buhrmann*) in view of *Raith et al.* (US 6,477,362; hereinafter *Raith*). Specifically, the Examiner alleges that *Buhrmann* teaches all the limitations of the invention in the pending claims, except for the limitation of a mobile terminal generating information regarding its location and subsequently transmitting such information. The Examiner alleges that *Raith* discloses this missing limitation. However, the Examiner does not provide any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, for making the combination of *Buhrmann* and *Raith*.

In order to make a *prima facie* case of obviousness, a teaching, suggestion, or incentive to combine the references in order to teach the claimed invention, must be found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Geiger*, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987). However, the teaching or suggestion to make the claimed combination must be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Like the present invention, *Buhrmann* is directed to providing the user of a cellular radio communications system with a location-dependent service profile. As is stated in the Background section of the present application (from line 32, page 1, to line 2, page 2) in reference to the Canadian application corresponding to *Buhrmann*:

The reference publication CA 2,195,487 discloses the definition of a so-called user zone, which consists of one or more cells or cell sectors. It is on [sic] the responsibility of a mobile telephone switching office (more commonly known as the MSC or Mobile services Switching Centre) to store a user zone profile and to modify a service profile for a cellular telephone when that cellular telephone is situated within a user zone.

Buhrmann discloses a prior art arrangement where location-specific handling of incoming calls takes place in response to the network determining (i.e., reading from a network-based location register) that the subscriber is either at remote location "A" or "B". However, in *Buhrmann* and the other prior art, it is **the network** which plays the prominent role in discovering the location of the mobile terminal in respect to the service areas. For example, when *Buhrmann* describes how the network establishes a communication link between a certain terminal and a certain MTSO by determining whether the terminal is within a user zone (see col. 11, line 59, to col. 13, line 14), it is a processor within the MTSO that is responsible for determining the location of the terminal (see especially col. 12, lines 40-64). As was discussed in the previous Amendment, the responsibility for generating the location information and subsequently communicating it to the service server is given to **the mobile station** in independent Claims 1, 5, and 7 of the present application.

On the other hand, *Raith* is directed to using the mobile identification number (MIN) as part of the system access messaging of a radiocommunication system, thereby ignoring typical access rules, when it is recognized that an emergency call is being made (Summary, in col. 3, lines 20-30, of *Raith*). According to *Raith*, in the prior art, "adjunct systems" (i.e., "systems [for locating mobile terminals] which may be completely independent of the radiocommunication system or which may share various components (i.e., an antenna) with the radiocommunication system but which processes signals separately therefrom"; col. 1, lines 59-62, *Raith*) did not use the "phone number" of the mobile terminal in their "adjunct scanning units", and therefore could not forward this number to an emergency service center during an emergency (col. 3, lines 1-17, of *Raith*). *Raith*'s solution is to use "its MIN in transmitted RACH messages instead of its valid TMSI or IMSI" when it is recognized that the mobile terminal is making an emergency call, thereby allowing the adjunct scanning stations to "forward this information to emergency service center 8, along with the location information generated by the location processing center 7" (the description of FIG. 4 in general; in particular, line 60 of col. 6 to line 2 of col. 7, *Raith*). It should be noted that the "location processing center 7" which generates this location information is completely separate from the mobile terminal (see FIG. 1 of *Raith*), and operates as part of the network. In other embodiments, *Raith* suggests that the IMSI or TMSI may be used in place of the MIN (col. 7, lines 3-8, *Raith*).

There is no teaching, suggestion, motivation, or incentive, either implicit or explicit, to combine *Buhrmann* and *Raith*. *Buhrmann* is directed to providing location-dependent consumer

services, such as discounted billing rates, which may change as a mobile terminal roams from one area to another (e.g., "...changing the service selection offered to a mobile station by the communications system in response to an indication of the arrival of the mobile station in said localized service area, ..."; Claim 1, lines 8-10), while *Raith* describes an alternate signalling system to be used when an emergency call is being made by a mobile terminal.

"When the incentive to combine the teachings is not readily apparent, it is the duty of the Examiner to explain why combination of the reference teachings is proper ... Absent such reasons or incentives, the teachings of the references are not combinable" (*Ex Parte Skinner*, 2 USPQ 2d 1788 (B.P.A.I. 1987)). The Examiner's explanation of the motivation to combine these two references is that "... it would have been obvious to one of ordinary skill at the time the invention was made to modify [*Buhrmann*] by specifically providing for mobile stations, generated messages describing the location of the mobile for the purpose of informing the system as to the location of the mobile in case of [an] emergency" (Office Action, page 3).

This passage from the Office Action appears to assume the existence of the combination of *Buhrmann* and *Raith* in order to provide a motivation for combining *Buhrmann* and *Raith*. In other words, the Examiner appears to be engaged in impermissible "hindsight reconstruction", where individual elements from disparate pieces of the prior art are combined in order to create the invention claimed in the present invention. *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780 (Fed. Cir. 1992) ("The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. [The cited references] fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner and endorsed by the board. ... Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Id.*.)

In summary, the Examiner has failed to establish a *prima facie* case of obviousness, because there is no motivation or suggestion for making the combination of *Buhrmann* and *Raith*, except for applicant's patent application. At least because impermissible hindsight was used in

making the §103 rejection of independent Claims 1, 5, and 7 of the present application based on the combination of *Buhrmann* and *Raith*, the §103 rejection of independent Claims 1, 5, and 7 is invalid. At least through their dependence of Claims 1, 5, and 7, it is believed the §103 rejection of dependent Claims 2-4, 6, and 8-12 are also invalid. Withdrawal of the §103 rejection is respectfully requested.

Applicant believes the pending claims are in condition for allowance, which is respectfully requested.

Respectfully submitted,

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